

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner now rejects claims 13-16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,843,789 to Goble (hereinafter "Goble").

In response, independent claims 13 and 16 have been amended to clarify their distinguishing features by incorporating features from original claim 15. Consequently, claim 15 has been canceled. Specifically, with regard to claim 13, the same has been amended to recite:

"determining subject tissue based on a change of the high frequency power based on the maximal current value flowing to the subject tissue and the time up to the maximal current value."

With regard to claim 16, the same has been amended to recite:

"detecting the maximal current value flowing to subject tissue and the time up to the maximal current value."

The amendments to claims 13 and 16 are fully supported in the original disclosure, such as at original claim 15. Thus, no new matter has been introduced into the disclosure by way of the present amendments to independent claims 13 and 16.

In the Official Action, the Examiner argues that the features of claim 15 are disclosed in Goble, citing from column 20, line 39 to column 22, line 11 of Goble in support of such rejection. Applicants respectfully disagree for at least the following reasons.

Although Goble describes a variation in the voltage, current, impedance, etc., it does not disclose or suggest identifying target tissue using the time up to the maximal current value to perform output control, as was recited in claim 15.

With regard to the rejection of claims 13-16 under 35 U.S.C. § 102(b), an electric surgery method having the features discussed above and as recited in independent

claims 13 and 16, is nowhere disclosed in Goble. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”<sup>1</sup> independent claims 13 and 16 are not anticipated by Goble. Accordingly, independent claims 13 and 16 patentably distinguish over Goble and are allowable. Claim 14 being dependent upon claim 13 is thus at least allowable therewith (claim 15 being canceled). Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 13-16 under 35 U.S.C. § 102(b).

Furthermore, new claims 17 and 18 have been added to further define the patentable invention. New claims 17 and 18 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 17 and 18. Applicants respectfully submit that new independent claims 17 and 18 patentably distinguish over the prior art and are allowable for at least the following reasons.

The electric surgery methods of claims 17 and 18 recite identification of target tissue by comparing the maximal current value flowing to the subject tissue with a first predetermined threshold value, and with respect to the comparison result, further compares the maximal current value with a second predetermined threshold value. Goble simply does not disclose or suggest such features.

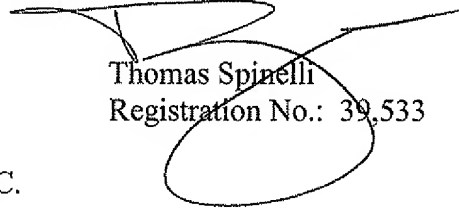
In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

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<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

conference with Applicant's attorneys would be advantageous to the disposition of this case,  
the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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